

**Remarks**

**Status of the Application**

Claims 1-8, 10-14, 16-29, 31-33, 35, 37-39 72-83 and 85-93 are pending with the entry of this amendment. Claims 1-8, 10-14, 16-29, 31-33, 35, 37-39 72-83 are indicated in the office action as being withdrawn from consideration as being directed to a non-elected invention, but that assertion is erroneous for reasons explained below.

Claims 85-86 and 91 are amended herein.

**Response to Restriction Requirement**

Applicants respectfully traverse the new restriction requirement. A proper restriction requirement requires that: a) the inventions must be independent or distinct as claimed, and b) there would be a serious burden on the examiner if restriction is not required. MPEP 803.

The original restriction requirement in the instant case was as follows:

- “I: Claims 1-71 and 84-115, drawn to a parallel reaction system, classified in Class 422, subclass 102.
- II: Claims 72-83, drawn to a reaction block, classified in class 422, subclass 102.
- III: Claims 116-119, drawn to a lid attachment component, classified in class 422, subclass 99.” (Restriction Requirement mailed October 19, 2005).

Applicants elected Group I, without traverse. (Response to Office Action filed January 27, 2006).

Now, in the instant office action (which was made final even though it is the first action after an RCE) the original restriction requirement is recharacterized, stating that Applicants had elected not just a parallel reaction device, but a “parallel reaction device comprises of a reaction block engaged with top and bottom lids, the top lid having protrusions for pressing a top gasket against inlets of the reaction wells.” Applicants’ amended claims are, according to the restriction requirement, directed to a separate and distinct invention, namely, “a

parallel reaction device comprises of a reaction block with recessed regions, a band, a bottom lid and a top lid without protrusions.”

The office action does not even attempt to point out why the inventions are separate and distinct, or provide any reasoning as to “why there would be a serious burden on the examiner if restriction is not required,” which explanation is required under MPEP 808.02. In fact, it would not be possible to prove a serious burden because every single claim element in Applicants’ pending claims has been pending and under examination since the application was originally filed. Applicants merely introduced into claim 1 claim limitations from originally filed dependent claims. The claim limitation reciting recessed regions is from original claim 35. The bands, top lid, and bottom lid are from original claim 36. Nor does the presence or absence of protrusions on the top lid and bottom lid distinguish the claimed device from that of the originally filed claims, as originally filed claims 11, 16, 21 and 24 all relate to protrusions. Each of the dependent claims from which claim limitations were introduced into claim 1 is included in elected Group I, and therefore has been under examination since October 2005.

Since each element of the currently pending claims has already been the subject of examination in the instant case, the new restriction requirement is clearly improper and should be withdrawn.

### **Request for Withdrawal of Finality**

Pursuant to MPEP § 706.07(c), Applicants request withdrawal of the finality of the rejection. The rejection should not have been made final because Applicants have not received from the Office a substantive response to their previous amendment. The instant Office Action is not in compliance with MPEP 707.07(f), which requires that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” This section of the MPEP states also that a final rejection “should include a rebuttal of any arguments raised in the applicant’s response.” The instant final rejection does not include such a rebuttal.

The instant office action does not take note of Applicants’ arguments made in their RCE submission and answer the substance of them. In that submission, Applicants amended claim 1 to incorporate limitations from originally filed dependent claims, and provided

arguments as to why the claim amendments obviated the rejections of record. Instead of responding to the amendments and arguments, the office action simply dismisses them by asserting that the amended claims are directed to a non-elected invention. For reasons discussed above, that assertion is not correct because all of the limitations that were added to the amended claims were taken from dependent claims that had long been pending and under consideration in the instant application. Applicants are entitled to a substantive response to their amendments and arguments.

Because this ground of rejection was made final without Applicants' having received the full and fair hearing to which they are entitled, Applicants respectfully request that the Examiner withdraw the finality of the rejection. See, MPEP § 706.07 ("The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.").

### **The Amendments**

The amendments to claims 85, 86, 87 and 91 do not add new matter to the application as originally filed.

### **The Objections to the Drawings**

The drawings stand objected to under 37 CFR 1.83(a) for allegedly not showing every feature of the invention specified in the claims. First, the objection asserts that the drawings do not show the protruding annular ridges around the apertures of the top lid. Applicants respectfully point out that annular ridges **116** are shown in, for example, Figure 1.

Second, the objection asserts that the drawings do not show a band having a pair of top and bottom hinges and a pair of top and bottom latches. Applicants respectfully point out that Figures 3A and 3B, for example, shows a band **204** to which are attached a pair of bottom hinge components **224**, a pair of top hinge components **240**, a top latch component **222** and a bottom latch component **236** (see also, the specification at pages 11-13). See also, Figure 5A, which shows a band **504** to which are attached a pair of bottom hinge components **510**, a pair of top hinge components **514**. Also attached to band **504** are a bottom latch component **512** and a

top latch component **508** (see also, the specification at pages 20-21, bridging paragraph). Figure 9 also shows the components that, according to the objection, are not shown in the drawings.

In view of the foregoing, Applicants respectfully submit that the objection to the drawings is improper and should be withdrawn.

### **The 35 USC § 112 Rejections**

Claims 86-88 and 91-93 stand rejected under 35 USC § 112, second paragraph, as allegedly being unclear for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

According to the rejection, claim 86 recites each hinge component independently comprising a male or female lift-off hinge component, and it is not clear how the band would get engaged with the lids in the case where all of the components are only male or only female hinge components. Applicants have amended claim 86 to clarify that if one hinge component is a female hinge component, the corresponding hinge component is a male hinge component. The amendment is believed to obviate this ground of rejection as to claim 86.

Claim 87 is rejected on similar grounds, but with respect to latch components as opposed to hinge components in claim 86. Applicants have amended claim 87 in an analogous manner to claim 86, to specify that if one latch component is a latch body, the corresponding latch component is a keeper plate, and vice versa. This amendment is believed to obviate the ground of rejection as to claims 87 and 88 (which depends from claim 87).

Claim 91 is allegedly unclear and indefinite in reciting that through holes in the top lid are arranged such as to ‘axially align’ with reaction wells of the reaction block. That the reaction block is not positively claimed as a part of the invention is said to render the well arrangement unspecified. Applicants have amended claim 91 to recite that the aperture axially aligns with at least one reaction well disposed in a reaction block *when the reaction block is placed in the reaction block container*. This amendment is believed to obviate this ground of rejection.

Claim 93 is said to be indefinite for lacking antecedent basis for “the aperture.” Applicants respectfully traverse this ground of rejection, as claim 91, from which claim 93 depends, recites “at least one aperture,” thereby providing antecedent basis for “the aperture” in claim 93.

### **The 35 USC § 103(a) Rejections**

Claims 85-93 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over Stanchfield et al. (US Patent No. 6,054,100) in view of Sanadi (US Patent No. 5,516,490). As the office action acknowledges, Stanchfield does not teach an apparatus that includes a band to which hinge components and latch components are attached. Applicants respectfully disagree that the rejection establishes *prima facie* obviousness, but in the interests of expediting prosecution, Applicants have amended claim 85 to recite that “the band is configured to be disposed around opposing surfaces, and retained with recessed regions of a reaction block when the reaction block container is attached to the reaction block.” The cited references, taken in combination, provide no teaching or suggestion of a reaction block container having such a band as one component. Applicants accordingly request that this ground of rejection be withdrawn as to independent claim 85, and also claims 86-93, each of which ultimately depends from claim 85.

Applicants also respectfully request that their arguments presented in their RCE submission with respect to the rejections of improperly withdrawn claims 1-8, 10-14, 16-29, 31-33, 35, 37-39 72-83 be considered by the Examiner.

**Conclusion**

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for examination. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned attorney at 858-812-1547.

Respectfully submitted,

/ Timothy L. Smith, Reg. No. 35,367 /

Timothy L. Smith, J.D., Ph.D.  
Reg. No. 35,367

GENOMICS INSTITUTE OF THE NOVARTIS RESEARCH FOUNDATION  
10675 John Jay Hopkins Drive, Suite E225  
San Diego, CA 92121  
Tel: (858) 812-1547  
Fax: (858) 812-1981